

### **REMARKS**

Applicants thank the Examiner for the telephonic interview granted on January 11, 2006. Claims 26-45 are now pending in the application. The amendments to the claims are of equivalent scope as those previously presented and, as such, do not constitute a narrowing amendment. The amendments are for purposes of clarification and do not raise new issues requiring further examination. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

### **SPECIFICATION**

Applicants note that the specification has been amended as indicated above to include "[a] majority of first and second walls 40, 42 are generally parallel to one another." This description has been added to provide support in the written description for the amendment to claim 37. This feature can be found in the drawings as originally filed, and therefore, does not constitute new matter.

### **REJECTION UNDER 35 U.S.C. §§ 102 AND 103**

Claims 26, 30, 34, 35, 37, 42 and 44 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Holzer, Jr. (U.S. Pat. No. 5,103,565, hereinafter "Holzer"). This rejection is respectfully traversed.

Claims 26, 30, 34, 35, 37, 42 and 44 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Langhoff (U.S. Pat. No. 5,306,025, hereinafter "Langhoff"). This rejection is respectfully traversed.

Claims 26, 34-37, 44 and 45 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Wright (U.S. Pat. No. 5,433,457, hereinafter "Wright"). This rejection is respectfully traversed.

Claims 26, 27, 30-33 and 35 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Atkinson et al. (U.S. Pat. No. 3,033,251, hereinafter "Atkinson"). This rejection is respectfully traversed.

Claims 26-28 and 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Beale (U.S. Pat. No. 3,977,287, hereinafter "Beale"). This rejection is respectfully traversed.

Claim 32 stands rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Langhoff. This rejection is respectfully traversed.

Claims 27, 28, 39 and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Holzer in view of Tseng (U.S. Pat. No. 5,664,792, hereinafter "Tseng"). This rejection is respectfully traversed.

Claims 27, 28, 39 and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Langhoff in view of Tseng. This rejection is respectfully traversed.

Claims 27, 28, 39 and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wright in view of Tseng. This rejection is respectfully traversed.

Claims 28 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Atkinson in view of Tseng. This rejection is respectfully traversed.

Claims 37-39, 42 and 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Atkinson in view of Holzer. This rejection is respectfully traversed.

Claims 40 and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Atkinson in view of Holzer, as applied to claims 37 and 39 above, and further in view of Tseng. This rejection is respectfully traversed.

At the outset, Applicants respectfully disagree with the Examiner's position regarding the lack of consideration given to what the Examiner considers to be "functional language." Specifically, the Examiner has indicated in his rejection of claims 26 and 37 that the claim language including "said angularly disposed edge section generally defining a reciprocating axis of said saw blade," may be rejected in view of the prior art "[b]ecause the applied prior art all have such an edge capable of being reciprocated along that edge (e.g., either by a tool/machine or by hand)."

Applicants respectfully remind the Examiner that there is no known existing statutory law or caselaw permitting the Examiner to disregard functional language in a claim when making a rejection. Courts have actually held functional language to be allowable and even necessary at times.

We take the characterization "functional", as used by the Patent Office and argued by the parties, to indicate nothing more than the fact that an attempt is being made to define something (in this case, a composition) by what it *does* rather than by what it *is* (as evidenced by specific structure or material, for example). In our view, there is nothing intrinsically wrong with the use of such a technique in drafting patent claims. Indeed we have even recognized in the past the practical *necessity* for the use of functional language. See, for example, *In re Halleck*, 57 CCPA 954, 421 F.2d 911, 164 USPQ 647 (1970). We recognize that prior cases have hinted at a possible distinction in this area depending on the criticality of the particular point at which such language might appear. Our study of these cases has satisfied us, however, that any concern over the use of functional language at the so-called "point of novelty" stems largely from the fear that an applicant will attempt to distinguish over a reference disclosure by emphasizing a property or function which may not be mentioned by the reference and thereby assert that his claimed subject matter is novel. Such a concern is not only irrelevant, it is misplaced. In the first place, it is elementary that the mere

recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

We are convinced that there is no support, either in the actual holdings of prior cases or in the statute, for the proposition, put forward here, that “functional” language, in and of itself, renders a claim improper. We have also found no prior decision of this or any other court which may be said to hold that there is some other ground for objecting to a claim on the basis of *any* language, “functional” or otherwise, beyond what is already sanctioned by the provisions of 35 U.S.C. 112. (Footnotes omitted). In re Swinehart and Sfiligoj, 169 USPQ 226, 228-9 (1971).

Applicants additionally note that “[r]ejections in patent claims based on the language of the claim rather than the prior art must be sanctioned by the provisions of Section 112.” Chisum on Patents, §8.04[3], p. 8-141 (2005). In the present Office Action there is no Section 112 issue raised by the Examiner. The Examiner merely appears to be substantially discounting the patentable weight given to the language of claims 26 and 37 regarding the “angularly disposed edge section generally defining a reciprocating axis of said saw blade.” Applicants respectfully submit that this failure to seriously consider what the Examiner considers to be “functional” claim limitations is improper in view of the established precedent noted above.

When given the appropriate consideration, Applicants respectfully submit that claims 26 and 37 clearly distinguish from the prior art. The Examiner has listed a large number of patents including an angled surface on a mounting portion of a saw blade. However, all of these references fail to teach the saw blade disclosed in claims 26 and 37 including the angularly disposed edge section defining a reciprocating axis of the blade.

Applicants first submit that any rejection using the references cited is clearly inappropriate under 35 U.S.C. §102(a) because of the clear lack of the structural limitation noted above found in claims 26 and 37. The Examiner repeatedly notes that “the saw blade structure of” the cited references “will meet this limitation if used in a tool that will reciprocate the saw blade in the claimed manner or otherwise used (i.e., in a hand tool) such that the saw blade and support structure will reciprocate in the claimed manner.” The requirement of 35 U.S.C. §102(a) is that “the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.” The references cited by the Examiner clearly fail to teach the “angularly disposed edge section generally defining a reciprocating axis of said saw blade” as required by claims 26 and 37. Applicants further note that in claim 37 the “angularly disposed edge section” is further defined as engaging one of said pair of lateral walls of said support structure. Applicants note that claim 37 specifies “a majority of each of said lateral walls being generally parallel to one another.” Applicants submit that the cited references further fail to disclose this feature. As such, Applicants respectfully request reconsideration and withdrawal of these rejections.

With specific reference to the art cited by the Examiner, Holzer shows an angular surface in Figure 4. However, this surface does not define a reciprocating axis for blade 32 and does not engage one of a lateral pair of walls of the support structure. There is not even a suggestion that this surface may define a reciprocating axis in an alternate use. Rather, as commonly understood by one of skill in the art, the reciprocating axis is generally that of the portion of blade 32 extending from the angled portion and generally

parallel to the back edge of blade 32. Additionally, Applicants note that claim 37 specifies “a majority of each of said lateral walls being generally parallel to one another.” This feature is clearly not disclosed in Holzer.

The Examiner makes a similar argument regarding saw blade 4 in Langhoff. Specifically, the Examiner notes the angularly disposed edge section as “uppermost end of 14 as shown in Figure 6.” However, Langhoff specifically discloses “[a] clamping device 3, which is driven with the plunger 2, according to saw stroke S.” (col. 3, lines 32-33). As seen in the figures, stroke S is clearly not defined along the angularly disposed edge section. Furthermore, the uppermost end of 14 does not engage one of a lateral pair of walls of the support structure, as cited in claims 37. Applicants note that claim 37 specifies “a majority of each of said lateral walls being generally parallel to one another.” This feature is clearly not disclosed in Langhoff.

In Wright, the Examiner appears to define a portion of saw blade 48 that is not present in the drawings. The Examiner notes that the angularly disposed edge section is “at the uppermost end of 14 as shown in Figure 6.” This appears to be the section that the Examiner references in Langhoff, as no angularly disposed edge section appears in Wright.

With regard to Atkinson, the Examiner calls out the top edge in Figure 5 as the second edge of claims 26 and 37. The Examiner further notes that the angularly disposed edge section is “at least the top right edge section of the shank as viewed in Figure 5.” Figure 5 merely appears to show an edge surface laterally offset from the back edge. Applicants fail to see how the top edge in Figure 5 includes an angularly disposed edge section. In order to further clarify claims 26 and 37, Applicants have

amended the claims to include "a first portion of said second edge being laterally offset..., a second portion of said second edge including an angularly disposed edge section...disposed at an angle relative to said first portion."

In Beale, the Examiner notes that the left edge in Figure 2 is the second edge and the angularly disposed edge section is the angled edge on the wider portion of the shank. Again, Applicants note that this surface does not define a reciprocating axis for blade 30. There is not even a suggestion that this surface may define a reciprocating axis in an alternate use. Rather, as commonly understood by one of skill in the art, the reciprocating axis is generally that of the portion of blade 30 extending from the angled portion and generally parallel to the back edge of blade 30. Further, Figure 7 indicates that this is the intent of the invention of Beale, specifically stating "cutting blade 30 reciprocates between a phantom-line indicated terminal downstroke position designated A." (col. 3, line 1-3).

Claims 27-36 depend from claim 26 and claims 38-45 depend from claim 37, and should be in condition for allowance for the reasons set forth above. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 26-45.

If the Examiner were to attempt a 35 U.S.C. §103 rejection of these claims on the grounds of obviousness, Applicants note that this rejection would be improper as well. Specifically, as stated above, Applicants note that there is no suggestion that the angled surfaces shown in the prior art cited by the Examiner define a reciprocating axis of a saw blade. "The mere fact that prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the

desirability of the modification.” In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992)(citing In re Gordon, 733, F.2d 900, 902, 221 USPQ1125, 1127 (Fed. Cir. 1984)). Here, the Examiner has modified the angled edges of the references to define a reciprocating axis without any suggestion or motivation to do so provided by the art cited. The references actually teach away from using the angled surfaces as the reciprocating axes of the saw blades, as indicated in the drawings and specification, as well as by common knowledge of those skilled in the art.

Finally, Applicants note that in order to create his rejections, the Examiner relied upon impermissible hindsight to create the features required by the claims. “The invention must not be viewed with the blueprint drawn by the inventor, but in the state of the art that existed at the time. The invention must be evaluated not through the eyes of the inventor, who may have been of exceptional skill, but as one of ‘ordinary skill.’” Interconnect Planning Corp. v. Feil, 744 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985). Here, the Examiner has provided no suggestion or motivation for the rejection from the references. Rather, the Examiner appears to rely on the present disclosure to provide the blueprint for the modification of the references.

## **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt

and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: 2-3-06

By: Ryan W. Massey  
Ryan W. Massey, Reg. No. 38,548

HARNESS, DICKEY & PIERCE, P.L.C.  
P.O. Box 828  
Bloomfield Hills, Michigan 48303  
(248) 641-1600

RWM/JMP  
J:\HDP Forms\Client Forms\BlackDecker (0275\_, 6736, 8913)\Amendment Form.dot